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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,123	07/10/2000	William N. Schilit	FXPL-01022US0 MCF/TAW	8793
23910	7590	03/25/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			HALIM, SAHERA	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/613,123

Applicant(s)

SCHILIT ET AL.

Examiner

Sahera Halim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to communication filed on February 24, 2005.
2. Claims 1, 10, and 11 have been amended.
3. Claim 9 has been cancelled.
4. Claims 1-8 and 10-14 are pending.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 10, and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner failed to find support in the specification for the limitations of “**hiding** the remainder of the content portion not associated with the at least one new link indications from the display of the mobile device” and “**hiding** the remainder of the content portion not associated with the identified address from the display of the mobile device” in claims 1, 10 and 11.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is the difference between content portion and Web content data. Content portion is also web content data since it is detected from a web page data file. For examination purposes they are assumed to be the same content.

9. Claim 11 recites the limitation " the identify address " in the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether the identify address is the same as the e-mail address. For examination purposes they are assumed to be the same.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, and 12 – 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin, Jr. et al., U.S. Pat. No. 6,610,105 (hereinafter Martin).

1. Regarding claim 1, Martin discloses a method as claimed, for proving data detection from Web content information for mobile devices comprising (col. 2, line 34 – col. 3, line 51):

receiving a URL from a user (col. 2, line 47 – 49, the server receives a request from a mobile device to access a portal, which is done through a URL request);

accessing a Web page data file identified by the URL (col. 8, line 1 – 6, the portal is accessed by the URL);

detecting a data portion from the Web page data file, the data portion adapted to be enhanced by introducing a link indication to a service (See Fig. 3B and col. 9, lines 7 – 37; the portal provides a number links on the mobile device) ;

searching the content to identify Web content data, the web content data included in content portion and adapted to be accessed to provide at least one new link service from a mobile device through a wireless connection (col. 3, line 22 – 37 and col. 9, line 18 – 37, the user access services through links such as stacks on a mobile device);

displaying only the identified web content data using the link indication on a display of the mobile device (col. 9, line 18 – 37, once the links is selected, data corresponding to the link is displayed on the mobile device).

hiding the remainder of the content portion not associated with the at least one new link indication from the display of the mobile device (Fig. 4D and col. 11, line 65 – col. 12, line 17; when a user activates a link on the mobile device, the corresponding request will cause the host server to provide the same content but

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typically less content (due to its smaller display screen), which is means hiding some of the content and displaying only a portion).

2. Regarding claim 2, Martin teaches the steps of providing a user keypad selection enabling the link indication to be activated; and using the wireless connection to activate the link indication when the user keypad selection is made (col. 5, lines 52 - 63).

3. Regarding claim 12, Martin discloses the display is provided on a device consisting of one or more of the following:

an Internet phone (col. 5, line 18 - 25);

a personal digital assistant (col. 5, line 18 - 25); and

a two way pager ((col. 5, line 18 - 25).

4. Reference to claims 13 and 14, Boor teaches the detection occurs in a network server and within a Web browser (col. 12, line 17 – col. 13, line 14).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 –5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of De Boor et al., U.S. Pat. No. 6,675,204 (hereinafter Boor).

7. Regarding claim 3, Martin fails to disclose the Web content data is a telephone number. However, Boor teaches the web content data is a telephone number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Martin by Boor in order to enhance the system functionality.

8. Reference to claim 4, Martin fails to disclose the Web content data is a telephone number. However, Boor teaches the web content data is a telephone number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Martin by Boor in order to enhance the system functionality. Moreover, Martin and Boor fail to teach the link indication is activated by dialing the number. However, this feature is well known and would have been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of dialing a number.

9. Regarding claim 5, Martin fails teach the web content data is an address number. However, Boor discloses the web content data is an address number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the

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time the invention was made to modify Martin by Boor in order to enhance the system functionality.

10. Regarding claim 7, Martin does not teach the Web content data is an e-mail address. However, Boor discloses the Web content data is an e-mail address (col. 13, lines 28 – line 58). It would have been to a person having ordinary skill in the art at the time the invention was made to include the above limitation into Martin's invention to increase system functionality.

11. Claims 10 –11, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Buckham et al., U.S. Pat No. 6,662,016 (hereinafter Buckham).

receiving a URL from a user (col. 2, line 47 – 49, the server receives a request from a mobile device to access a portal, which is done through a URL request);

accessing a Web page data file identified by the URL (col. 8, line 1 – 6, the portal is accessed by the URL);

detecting a data portion from the Web page data file, the data portion adapted to be enhanced by introducing a link indication to a service (See Fig. 3B and col. 9, lines 7 – 37; the portal provides a number links on the mobile device) ;

searching the content to identify Web content data, the web content data included in content portion and adapted to be accessed to provide at least one new link



service from a mobile device through a wireless connection (col. 3, line 22 – 37 and col. 9, line 18 – 37, the user access services through links such as stacks on a mobile device);

displaying only the identified web content data using the link indication on a display of the mobile device (col. 9, line 18 – 37, once the links is selected, data corresponding to the link is displayed on the mobile device).

hiding the remainder of the content portion not associated with the at least one new link indication from the display of the mobile device (Fig. 4D and col. 11, line 65 –col. 12, line 17; when a user activates a link on the mobile device, the corresponding request will cause the host server to provide the same content but typically less content (due to its smaller display screen), which is means hiding some of the content and displaying only a portion); and

providing a user keypad selection of a mobile device (col. 5, lines 52 - 63).

Although Martin discloses substantial features of the claimed invention (explained above), he fails to disclose that the web content data is an address and providing a user keypad selection of a mobile device enabling a map to be provided showing a location for the identified address. However, in an analogous art, Buckham teaches displaying the address on a display of the mobile device and a map to be provided showing a location for the identified address (Fig. 1, numeral 147, Fig. 2, numeral 202, 204 and Fig. 4 and col. 2, lines 24 – col. 4, lines 8). Having the teachings of Martin and Buckham, it would have been obvious for a person having ordinary skill in

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the art at the time the invention was made to include the above limitation into Martin in order to increase utilizations of the system.

Regarding claim 11, Boor discloses receiving a URL from a user (col. 4, lines 18 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);

identifying at least one email address from the content in the Web page (col. 13, lines 26 - 51);

displaying the identified email address for the user (col. 13, lines 26 - 51);

providing a user keypad selection of a mobile device (Fig.1, col. 9, lines 34 - 49 and col. 4, lines 18 - 46).

Nonetheless Boor does not disclose displaying the address on a display of the mobile device and an email initiation. However, Buckham teaches displaying the address on a display of the mobile device and an email initiation (co. 9, line 7 - 12 and Fig. 1, numeral 147, Fig. 2, numeral 202, 204). It would have been obvious for a person having ordinary skill in the art at the time the invention was made to modify Bore by Buckham order to enhance user stratification by providing more functionality to the system.

Claims 6 and 8 have the same similar limitations as to claims 10 and 11, therefore, they are rejected under the same rational.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,674,453 to Schilit et al.

U.S. Pat. No. 6,670,968 to Schilit et al.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner  
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March 13, 2005



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PRIMARY EXAMINER